

| | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------|--------------------------------|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number: 00167-456001 |
| <p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <hr/> <p>Date of Deposit</p> <hr/> <p>Signature</p> <hr/> <p>Typed or Printed Name of Person Signing Certificate</p> | Application Number 10/015,778 | Filed December 17, 2001 |
| | First Named Inventor Douglas D. Sjostrom | |
| | Art Unit 3734 | Examiner Victor X Nguyen |
| | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>38,524</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <hr/> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below!</p> <p><input type="checkbox"/> Total of no. forms are submitted.</p> | | |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Douglas D. Sjostrom
 Serial No. : 10/015,778
 Filed : December 17, 2001
 Title : CUTTING INSTRUMENT

Art Unit : 3734
 Examiner : Victor X. Nguyen
 Conf. No. : 4406

MAIL STOP AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005, New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of Examiners is requested because the rejections of record are not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. Applicant reserves all rights to address these and additional matters on appeal in any subsequent appeal brief.

The Examiner has rejected claims 25-43, 45-59, 64 and 65 as anticipated by U.S. Patent No. 1,360,016 to Porter ("Porter"). In addition, claim 44 has been rejected as obvious over Porter. The Examiner has rejected claims 25-41, 59, 64, and 70-77 as anticipated by U.S. Patent No. 6,053,923 to Veca et al. ("Veca").

Applicant respectfully disagrees with, and hereby asks the panel to review and reverse, these rejections for at least the following reasons.

Independent claims 25, 42, 59, 64 and 65 each recite, in part, a cutting instrument including an outer member and a helical knife. The outer member has an opening at least partially bounded by a cutting edge, as illustrated, for example, by the cutting edge 134 of the outer member 130 in applicant's Fig. 2 below, which bounds the opening at the end of outer member 130.

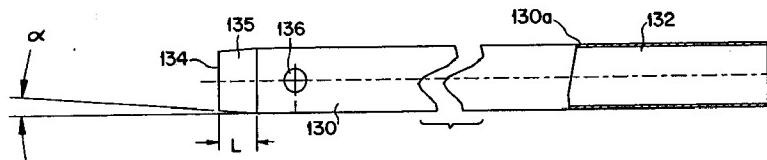
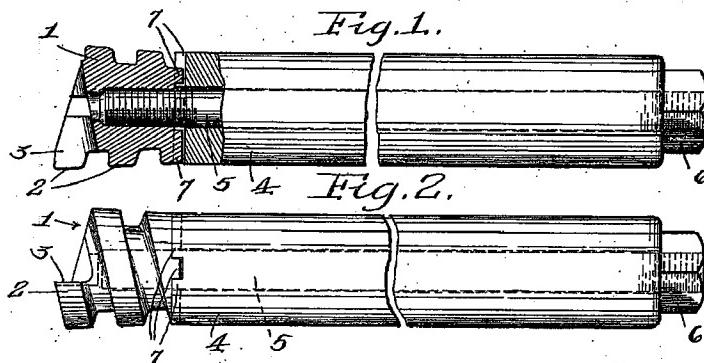


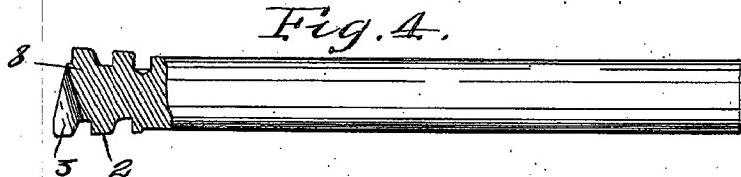
FIG. 2

As discussed in our prior response filed April 16, 2007, Porter's shank 4, which the Examiner equates with the claimed outer member, receives a screw 5, which is threaded into a helical blade 2 to attach the blade 2 to the shank 4 (see Fig. 1 reproduced below). Neither the helical blade's edge 3, which the Examiner equates with the claimed cutting edge, nor any other cutting edge of the instrument bounds an opening of the shank 4. The Examiner appears to be reading the claimed relationship of the cutting edge to the opening out of the claims, that is, that the cutting edge "bounds", i.e., "to form the boundary of: ENCLOSE", the opening. [Merriam Webster's Collegiate Dictionary, Tenth Edition, 1993.] There is nothing in Porter that suggests that the portion of the device that forms the boundary of, encloses, the opening of the shank 4 is a cutting edge.



As further discussed in our previous response, Porter's device cannot meet the functional limitations of claims 25, 59, 64, and 65. Claims 25, 64, and 65 recite that during use, the edge [of the helical knife] slices into tissue to draw the tissue proximally along the helical knife towards the sharp cutting edge. The helical blade 2 of Porter is not capable of drawing tissue proximally towards edge 3, because edge 3 is at the distal end of the helical blade. Claims 25, 59, and 64 recite that the helical knife edge and the cutting edge create a shearing action therebetween. Porter does not describe or suggest such action, nor is Porter's device capable of such action because edge 3 is part of helical blade 2.

Regarding the V-shaped cross section of claim 42, the Examiner refers to Fig. 4 of Porter, stating "(v-shaped is considered from the curve segment between element 2 and element 3) that defined a sharp, slicing edge which is perpendicular to a longitudinal extent of the slicing edge."



Claim 42 recites that the slicing edge has a V-shaped cross section perpendicular to a longitudinal extent of the slicing edge. The curve segment between element 2 and element 3 of Fig. 4 of Porter is not a V-shaped cross-section, which is illustrated, for example, in Fig. 4C of applicant's specification, shown below – the claimed V-shape is "V", whereas Porter's shape is

□.

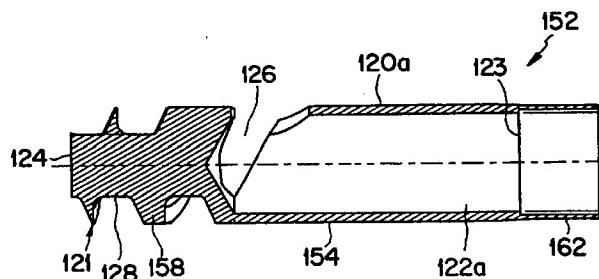
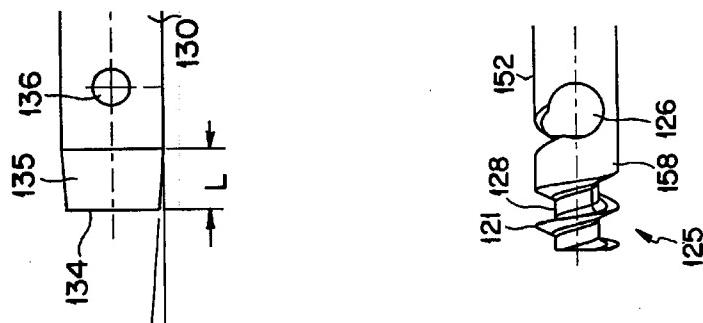
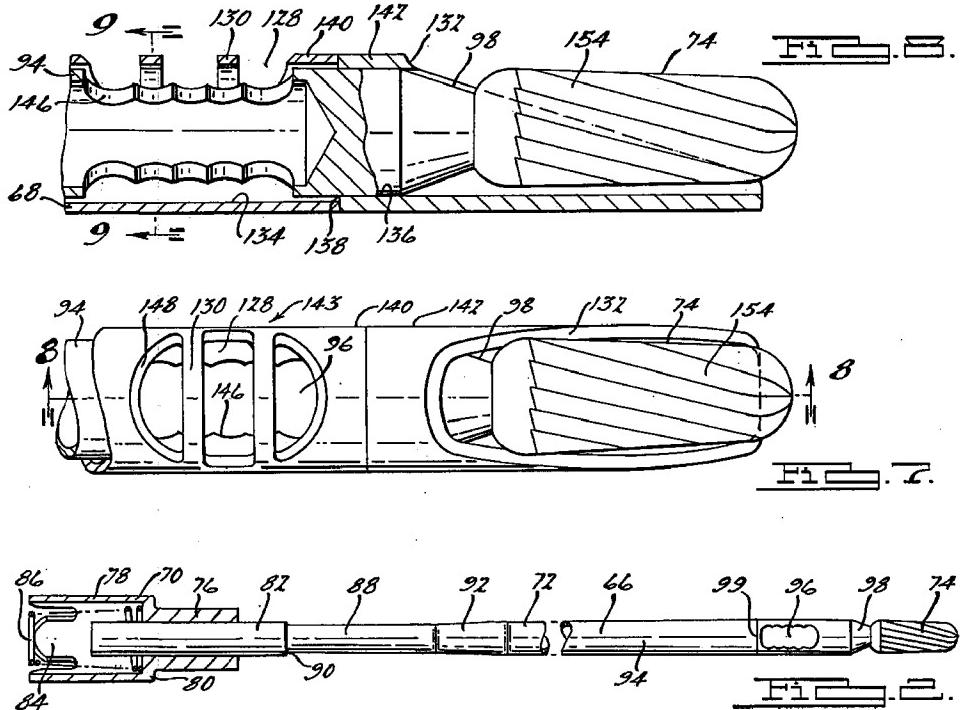


FIG. 4C

Regarding the rejections over Veca, independent claims 25 and 59 each recite, in part, that the helical knife edge and the cutting edge align in a plane substantially perpendicular to a longitudinal axis of the instrument to create a shearing action therebetween, as illustrated, for example, by the orientations of the cutting edge 134 and sharp-edged helix 121 in applicant's Figs. 2 and 3, shown below, which, with the figures overlayed, would show that the edges align in a plane substantially perpendicular to a longitudinal axis of the instrument.



As discussed in our prior response and as illustrated below, the conical transition region 98 of Veca, which the Examiner equates with the claimed cutting edge, and the abrader head 74 of Veca, which the Examiner equates with the claimed helical knife, which are both part of the inner tube assembly 66, do not create a shearing action therebetween.



Nor is there any indication in Veca that the conical transition region 98 even has a cutting edge, let alone there being the claimed alignment between the conical transition region and the abrader head. Furthermore, the conical transition region 98 does not at least partially bound an opening in the outer tube assembly 68, but rather shield 132 bounds the opening, and at no point does an edge of the helically-shaped teeth 154 of the abrader head 74 align with an edge of the shield 132 in a plane substantially perpendicular to a longitudinal axis of the abrader.

Claim 64 recites that an aspiration opening is located at a proximal portion of a helical knife, as illustrated, for example, in Figs. 3 and 4C of the applicant's specification reproduced above, in which the aspiration opening 126 forms the proximal, terminal part of the helical knife.

Applicant : Douglas D. Sjostrom
Serial No. : 10/015,778
Filed : December 17, 2001
Page : 5 of 5

Attorney's Docket No.: 00167-456001 / 02-31-0385

As illustrated in Fig. 2 above, the aspiration opening 96 of Veca is not located at any portion of the abrader head 74, but rather is spaced from the abrader head 74.

Therefore, the applicant submits that the rejected claims are patentable over Porter and over Veca.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: June 20, 2007



Phyllis K. Kristal
Reg. No. 38,524

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

40425518 (3).doc